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| 10/660,160 | 09/11/2003 | Daniel Joseph Heithoff | ROC920030088US1 | 7388 |
| 30206 7590 03/07/2008 IBM CORPORATION ROCHESTER IP LAW DEPT. 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829 | | | | |
| EXAMINER MYHRE, JAMES W | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,160

Applicant(s)

HEITHOFF ET AL.

Examiner

JAMES W. MYHRE

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Amendment filed on January 7, 2008. The Amendment did not add nor delete any claims, but did amend Claims 1, 2, 7, 9-17, and 20. Thus, the currently pending claims considered below remain Claims 1-21.

Specification

2. The Amendment filed on January 7, 2008 amended the specification to overcome the objection in paragraph 2 of the October 3, 2007 Office Action. Therefore, the Examiner hereby withdraws that objection.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 12-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Amendment filed on January 7, 2008 attempted to overcome the rejection of Claims 12-16 as being directed towards non-statutory subject matter by changing the preamble from "A signal bearing medium encoded with instructions, wherein the instructions when executed comprise:" to "A storage medium encoded with instructions, wherein the instructions when executed comprise:". While this change removes the

claims from being directed to a signal (i.e. electromagnetic energy per se), the changes do not place the Claims within statutory subject matter as they are now directed towards what could be interpreted as printed matter per se, i.e. a book containing instructions encoded (printed) therein that a person could read and execute. To eliminate the possibility of this interpretation and to place the claims squarely within statutory subject matter, the Examiner suggests the Applicant amends the claims to read: "A storage medium encoded with instructions, wherein the instructions when executed by a computer causes the computer to perform the steps of:" or some similar language.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fawcett (5,845,077).

Claims 1, 7, 12, and 17: Fawcett discloses a method, apparatus, storage medium, and server for recommending an offering based on data received from a client and a threshold, comprising:

a. receiving data/inventory from a client computer upon an occurrence of an event, such as installation of hardware, installation of software, detection of a

performance problem or detection of an error at the client (column 3, lines 3-14). The Examiner considers the disclosure by Fawcett that the system upon completion of the inventory of the software on the client's computer will automatically offer "up-to-date versions of the computer software" upon detection that the client's currently version "has defects that are known" as being the equivalent of detection of an error at the client;

b. comparing a subset of the plurality of fields (the received data) to a plurality of thresholds via a plurality of conditions to determine an associated recommended offering (column 2,, lines 30-45; column 3, lines 3-14; column 6, lines 12-32; and column 7, lines 23-44). The Examiner considers the disclosure by Fawcett that data about the current software, such as type, version number, obsolescence, etc. is compared to the latest available software to determine if an update or substitution is required as equivalent to comparing the data to a plurality of thresholds, e.g. the version number of the latest version, etc.; and

c. sending the associated recommend offering and an identification of a marketing channel upon meeting one or more of the compared conditions (column 3, line 3-14; column 7, lines 23-44; and column 10, lines 11-18). Fawcett discloses not only that the client would be presented with a list (one or more) of recommendations (offers) based on the comparison results, but also that the client "can purchase them electronically" or that "the information may also contain a list of retail outlets close to the user where the user may then purchase a new version of computer software on a storage media if desired."

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Claim 2: Fawcett discloses a method as in Claim 1 above, and further discloses the offer is an offer for a service (e.g. help files, automatic installation of software, correction of defects in software, etc.).

Claims 3 and 4: Fawcett discloses a method as in Claim 1 above, and further discloses the data comprises a hardware and/or software inventory of the client computer (column 1, lines 25-29 and column 2, lines 30-32).

Claims 5 and 6: Fawcett discloses a method as in Claim 1 above, but does not explicitly disclose the data comprises a performance inventory or a trend of the client. However, the Examiner considers the disclosure by Fawcett that the client computers periodically need updates such as new device drivers, new operating system calls, help files, etc., and that the "Fixes are also provided to allow the software product to function correctly on a new computer or with a different operating system environment" (column 1, lines 50-52) as being equivalent to a performance inventory.

Claim 8: Fawcett discloses an apparatus as in Claim 7 above, and further discloses saving a history of inventory changes (column 8, lines 53-55 and column 9, lines 46-52).

Claim 9: Fawcett discloses an apparatus as in Claim 8 above, and further discloses comparing a plurality of records in the history (column 6, lines 12-32 and column 7, lines 29-35).

Claim 10: Fawcett discloses an apparatus as in Claim 7 above, and further discloses the offer is for a service (e.g. help files, automatic installation of software, correction of defects in software, etc.).

Claim 11: Fawcett discloses an apparatus as in Claim 7 above, and further discloses the offer is for hardware (column 1, lines 25-29 and column 7, lines 35-44).

Claims 13 and 20: Fawcett discloses a storage medium and server as in Claims 12 and 17 above, and further discloses sending an identification of a marketing channel (i.e. a link) to the client in order to purchase the offer if accepted (column 10, lines 36-48). Fawcett discloses not only that the client would be presented with a list (one or more) of recommendations (offers) based on the comparison results, but also that the client "can purchase them electronically" or that "the information may also contain a list of retail outlets close to the user where the user may then purchase a new version of computer software on a storage media if desired."

Claims 14 and 21: Fawcett discloses a storage medium and server as in Claims 12 and 17 above, and further discloses periodically receiving updates of the inventory data from the client (column 9, lines 46-52 and column 10, lines 54-56).

Claims 15 and 16: Fawcett discloses a storage medium as in Claim 12 above, and further discloses saving a history of updates to the inventory data (backup copies and a log of updates)(column 8, lines 30-39 and column 9, lines 46-52).

Response to Arguments

5. Applicant's arguments filed January 7, 2008 have been fully considered but they are not persuasive.

The Applicant's arguments in reference to the newly added features in Claim 1 have been discussed at length in the expanded rejection above.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM
February 28, 2008

/James W Myhre/
Primary Examiner, Art Unit 3622